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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,620	07/24/2001	Judith F. Miller	MILJ/101/US	4970

2543 7590 08/02/2002

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EXAMINER

SNOW, BRUCE EDWARD

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 08/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/911,620

Applicant(s)

MILLER, JUDITH F.

Examiner

Bruce E Snow

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 8 and 10-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8 and 10-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19-20 rejected under 35 U.S.C. 102(b) as being anticipated by Eberl et al (4,681,587).

Referring to figure 3, Eberl et al teaches detachably coupling a “comfort” pad 3b to a breast prosthesis 1 utilizing hook-and-loop fasteners 7. The pad has a “shape generally congruent” to the first shape of the rear surface.

It is the Examiner’s position that the “**pad member 3b**” of Eberl et al is considered a “**comfort pad**” because it reduces the weight of the prosthesis making it more comfortable for the wearer, is constructed of materials such as cotton which is well known for its breathability and softness for objects that are in contact with the skin, etc.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-5, 7-8, 10-17, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brickman (3,161,200) in view of Eberl et al (4,681,587).

Brickman discloses a breast prosthesis 40, 80 having hook material 42, 44 (see figures 5-6) positioned on the front surface 46. The hook material is configured to engage loop material 76, 77 positioned in a bust cup 30 for releasable attachment. However, Brickman is silent in regards hook-and-loop fastener material on the rear surface of the breast prosthesis for attachment of a comfort pad.

Eberl et al teaches detachably coupling a "comfort" pad (3b and 4) to a breast prosthesis 1 utilizing hook-and-loop fasteners 7. It would have been obvious to one having ordinary skill in the art to have utilized the pad attached by hook-and-loop fasteners to the rear surface of the breast prosthesis as taught by Eberl et al with the prosthesis of Brickman to allow a substantially larger cavity reducing costs (see column 1, lines 32 et seq.) and further reducing the tendency to collapse. The hook and loop fasteners allow for easy removal for washing (see column 2, lines 1-2).

Referring to figure 3, some of the fasteners 7 are positioned along the periphery of the prosthesis.

Eberl et al teaches the fasteners are "strips" and therefore have a length greater than the width. Also, Brickman teaches length greater than width.

Eberl et al is silent whether the hook or loop portion of the fastener is attached to the rear of the prosthesis. It would have been an obvious reversal of parts to have either and would have been obvious to one having ordinary skill in the art. Note that Brickman teaches the hook portion position on the prosthesis.

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Lacking any criticality in the specification, the use of substantially triangular shape with rounded corners the lacked elements in lieu of that used in the references solves no stated problems and is considered an obvious matter of design choice. Additionally, this shape is well know in the art and would have been obvious to one having ordinary skill in the art. See Becker et al (5,895,423) figure 1, "prior art" and new cited references.

Response to Arguments

Applicant's arguments filed 5/20/02 have been fully considered but they are not persuasive. Applicant arguments state, "*the proposed combination fails to disclose rear hook material positioned on the rear surface of the breast prosthesis.*" As stated in the rejection: *Eberl et al is silent whether the hook or loop portion of the fastener is attached to the rear of the prosthesis. (See figure 3, elements 7 of Eberl et al) It would have been an obvious reversal of parts to have either and would have been obvious to one having ordinary skill in the art. Note that Brickman teaches the hook portion position on the prosthesis.* It is noted that claim 19 does not require this limitation.

Again, it is the Examiner's position that the "**pad member 3b**" of Eberl et al is considered a "**comfort pad**" because it reduces the weight of the prosthesis making it more comfortable for the wearer, is constructed of materials such as cotton which is well known for its breathability and softness for objects that are in contact with the skin, etc.

Conclusion

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E Snow whose telephone number is (703) 308-3255. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703)308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

bes
July 30, 2002

A handwritten signature in black ink, appearing to read 'BSN', with a long horizontal flourish extending to the right.

**BRUCE SNOW
PRIMARY EXAMINER**